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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/211,942	12/15/1998	JIM A. LARSON	884.078US1	9145
21186	7590	03/24/2005	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402				MENGISTU, AMARE
ART UNIT		PAPER NUMBER		
2673				

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/211,942	LARSON ET AL.
Examiner	Art Unit	
Amare Mengistu	2673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on Oct. 15, 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 8-16 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 8-16 and 20-27 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/15/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Objections

1. Claims 8-11,20 and 21 are objected to because of the following informalities: claim 8 is much better if rewritten as follows: after the preamble to start with "a stylus comprising: a housing... a personal computer...a personal digital assistant... (See, fig.4). Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
3. Claims 8-16,20,21,23-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification as originally filed does not provide support for the claims recitation "electronic voice signals". The phrase "electronic voice signal" was not described any where in the specification as recited in the above claims.

The specification as originally filed has failed to disclose "the processor to translate electronic voice signals into translated voice data, a wireless receiver to receive the electronic voice signals". The disclosure does not teach one skill in the art how to have a wireless receiver to receive an electronic voice signal within the PC (from the process).

The specification as originally filed does not provide support for the claim 13 recitation "The method of claims 13 and 14 wherein translating the electronic voice signal comprises: a personal computer (PC) receiving the electronic voice signal transmitted from the hand-held stylus; the PC translating the electronic voice signals." The electronic voice signal transmitted from the hand-held stylus and the PDA which receives and translates the electronic voice signal into voice data (as recited in claim 12), the specification as first filed does not teach or disclose that the translated voice signal comprises: a PC receiving the electronic voice signal. the PC translating the translated voice signal and the PC transmitting the translated voice.

4. Claims 8-11,20,21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim recitation of claim 8, lines 3-4 "**a wireless receiver to receive the electronic voice signals**" is not clear. Is this wireless receiver located inside the PC? If so, why you need a wireless receiver to receive electronic voice signal from the

processor of the PC? It is also not clear from where the electronic voice signal is generated?

In claim 8, lines 7 the phrase “**to display the translated voice data**” is confusing. How does it display the voice data? Shouldn’t the PDA have to receive the voice data before it display?

In claim 8, the last 2-3 lines “**output/ transmit the electronic voice signals**” are not clear. Which one of the electronic voice signals the applicant is referring to? The PC or the PDA electronic voice signals? Doesn’t the stylus have to receive or generate an electronic voice signals in order to output or transmit the voice signals?

The recitation of claims 13 “**wherein translating the voice signal comprises: a personal computer (PC) receiving the electronic voice signals transmitted from the hand-held stylus**” is very confusing. How the translated voice signal into voice data and stored in the PDA (recited in claim 12, last 2 lines), can be transmitted by the hand-held stylus to the PC?

The recitation of claims 13 and 14 “**wherein translating the voice signal comprises: the PC translating the electronic voice signals into translated vice data; and transmitting to the PDA**” is unclear. How does the *translated voice signal into voice data and stored in the PDA* (recited in claim 12, last 2 lines), again translated into voice data?

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12-15, are rejected under 35 U.S.C. 103(a) as being unpatentable over **Stevens, III** (5,769,643) in view of **Ohashi** (5,581,783) and **Register et al** (5,606,594).

As to claims 12-15, **Stevens, III** (hereinafter **Stevens**) clearly teaches that a PDA system comprising: a wireless transmitter to transmit electronic voice signals to a PC (see, figs.3 (64,63) and 4; col.3, lines 8-19, lines 35-39); a wireless receiver to receive voice from the PC (see, fig.3 (64,67), col.3, lines 20-22); a touch screen display to enter information in response to physical contact and to visually display the translated voice information (fig.4 (54,56)); col.3, lines 8-22); a stylus having a first end to provide physical contact with the touch screen (fig.4 (55)). **Stevens** also teaches that the PC having a processor (fig.3 (42)); a wireless receiver and transmitter (fig.3 (30)) voice data and the stylus communicating with the PDA (fig.3 (55,62); fig.4 (55,12)).

Stevens did not explicitly teach the stylus having a microphone to receive and a transmitter to transmit a voice signal. However, **Ohashi** clearly states that it is well known for a stylus to have a microphone to receive a voice signal (figs.2, 7 (71)) and a transmitter to transmit the voice signal to the personal computer (same as PDA) (fig.2 (16, 18); col.2, lines 32-53,col.5, lines 38-43). **Ohashi** also teaches that the stylus including a microphone (fig.2 (71)); a switch for the microphone (fig.7 (14), col.6, lines

64- col.7, lines 1) and able to communicate with the personal computer with wire (see, fig.11). It is obvious that the stylus of **Ohashi** has to have a power supply in order to function or to provide the information to the PDA and personal computer.

Therefore, it would have been obvious to one skill in the art at the time of the invention was made to substitute the stylus of Stevens with the that of **Ohashi**'s because this is an advancement for **Stevens**'s stylus in order to capture an image and voice data with the stylus and transferring the information data into the PDA of **Stevens**.

Stevens as modified by **Ohashi** did not disclose translating voice data. The patent of **Register et al** is cited to teach that it is conventional for a PDA or computer system to convert voice into electrical signal (see, col.2, lines 61-66, col.3, lines 65- col.4, lines 12).

Therefore, it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to use the method of converting the voice into electrical signal as taught by **Register et al** the system of **Stevens**, because this is an advantage to the user transmit voice information via the communication link between the stylus and PDA or computer which will allow the PDA to function as part of a voice and a data communication system.

Response to Arguments

6. Applicant's arguments with respect to claims 8-16,20-27 have been considered but are moot in view of the new ground(s) of rejection.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amare Mengistu whose telephone number is (703) 305-4880. The examiner can normally be reached on M-F, T-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (571)272-7681. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 272-7674 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.


Amare Mengistu
Primary Examiner
Art Unit 2673

*A.M
March 21, 2005